

REMARKS

Introduction

On February 15, 2006, Applicants filed a Request for Continued Examination ("RCE") amending claims 1, 8, 9 and 16, and adding claims 51-78. On May 2, 2006, a Restriction Requirement was mailed to the Applicants requiring restriction of the invention to one of three classified inventions (i.e., Invention I = claims 1-22; Invention II = claims 57-72 and 75-78; and Invention III = claims 51-56, 73 and 74). On June 1, 2006, Applicants elected to restrict the examination of the application to the group identified by the Examiner as Invention II (i.e., claims 57-72 and 75-78). Accordingly, claims 1-22, 51-56 and 73-74 were cancelled without prejudice and claims 79-107 were added in place of the cancelled claims.

A first Office Action after the RCE was mailed to Applicants on August 14, 2006. In this Action, the Examiner indicated that claims 1-22 and 51-107 were pending in the application, of which claims 51-107 had been constructively withdrawn from consideration. As the disposition of claims shown within the Office Action conflicted with Applicants' June 1st Response to the Restriction Requirement, Applicants' representatives (Christine E.M. Orich – Reg. No. 44,987 and Ryan O. White – Reg. No. 45,541) telephoned the Examiner on November 13, 2006 for clarification. In response to this telephone inquiry, the Examiner asserted that the June 1st Restriction Requirement should not have been mailed. More particularly, the Examiner indicated that since Applicants had received an action on the merits for the originally presented invention, the invention had been constructively elected by the original presentation for prosecution on the merits (citing 37 CFR 1.142(b) and MPEP § 821.03 on page 2 of the Office Action). As such, the Examiner maintained his position that claims 51-107 were to be withdrawn from consideration and cancelled claims 1-22 reinstated and examined on the merits.

Applicants do not acquiesce in the Examiner's position and hereby respectfully request that the Examiner recognize Applicants' original request to cancel claims 1-22 and to proceed with examining on the merits claims 57-72 and 75-107, which were duly elected without traverse in response to the May 2, 2006 Restriction Requirement. More particularly, even though it is not "general policy" to permit an applicant to shift inventions after an election has been made and an action given on the elected subject matter, Applicants respectfully remind the Examiner that this general rule is only a **policy** and is **not mandated by law** (see MPEP 819 where it is stated that "the applicant cannot, *as a matter of right*, file a request for continued examination (RCE) to obtain continued examination on the basis of

claims that are independent and distinct from the claims previously claimed and examined” (emphasis added).

Here, the Examiner acknowledges that the May 2, 2006 Restriction Requirement was sent in error and should not have been issued. Nonetheless, Applicants timely responded to the Restriction Requirement and requested that the Examiner restrict the examination of the application to claims 57-72 and 75-78. As MPEP 819 clearly indicates that the Patent Office has some discretion in permitting Applicants to file an RCE that is directed to claims that are independent and distinct from the claims previously claimed and examined, Applicants respectfully request that the Examiner recognize Applicants’ previous request to cancel claims 1-22 and thereby proceed with examining claims 57-72 and 75-107 on the merits.

However, if the Examiner should decide not to recognize Applicants’ request to cancel claims 1-22 and examine claims 57-72 and 75-107 on the merits, Applicants contend that the present invention is still patentably distinguishable over the teachings of Osborne et al in view of Bohrer et al. More particularly, in order for the Examiner to establish a *prima facie* case of obviousness three basic criteria must be met:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

Manual of Patent Examining Procedure (M.P.E.P.) Section 2143.

Here, the Examiner has rejected claims 1-22 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application No. 2004/0177445 to Osborne et al. (“Osborne”) in view of U.S. Patent No. 7,009,995 to Bohrer et al. (“Bohrer”). In the present case, independent claims 1, 9 and 16 are each directed to patient supports comprising, *inter alia*, at least one actuator and/or lift mechanism coupled to a controller area network for moving an intermediate frame relative to a base frame. While the Examiner acknowledges that Osborne has no teaching of a condition wherein an actuator or lift mechanism is coupled to a controller area network such as required by the present claims, the Examiner asserts that it would be obvious to combine the teaching of Bohrer with the teachings of Osborne to reach the present invention. Applicants respectfully disagree, particularly as Bohrer does not disclose the combination of at least one actuator or lift mechanism coupled to a controller area network to move an intermediate frame relative to a base frame. Bohrer, on the other hand, is directed to a very specific method for communicating among nodes within a CAN

network, and does not disclose, teach or suggest adapting the communication method to work with a hospital bed, or even suggest that it may be desirable to do so. Further, Bohrer does not disclose, teach or suggest the claim limitations that the Examiner has acknowledged are not present in Osborne.

In order for a combination of references to render an invention obvious, a combination of the teachings of all or any of the references must suggest, expressly or by implication, the possibility of achieving further improvement by combining such teachings along the line of the invention, *In re Sernaker*, 217 U.S.P.Q. 1, 5 (Fed. Cir.1983). The Examiner cannot pick and choose among the individual elements of assorted prior art references to recreate the claimed invention; rather, the Examiner has the burden to show some teaching or suggestion in the references to support their use in a particular claimed combination, *Smith-Kline Diagnostics, Inc. v. Helena Laboratories Corp.*, 8 U.S.P.Q.2d 1468, 1475 (Fed. Cir.1988). In this case, Applicants find no teaching or suggestion to make the cited combination to arrive at the invention defined by the claims presently at issue.

Indeed, the only suggestion that the Examiner has provided for combining these references is the cursory statement that “the skilled artisan would have found it obvious at the time the invention was made to couple the at least one actuator or lift mechanism to a controller area network since this type of communication protocol is well known and widely used due to its high speed and integrity, simple wiring construction and relatively low cost.” (Office Action, page 3). However, this broad and conclusory statement by the Examiner falls far short of establishing a *prima facie* case of obviousness, which requires a showing of “actual evidence. That is, the showing must be clear and particular.” *In re Dembiczak*, 175 F.3d 999 (Fed. Cir. 1999) (citing *C.R. Bard, Inc. v. 3M Sys., Inc.*, 157 F.3d 1340, 1352 (Fed. Cir. 1998)). “Broad statements regarding the teaching of multiple references, standing alone, are not ‘evidence.’” *Id.* (citing *McElmurry v. Arkansas Power & Light Co.*, 995 F.2d 1576, 1578 (Fed. Cir. 1993)). “Combining prior art references without evidence of such a suggestion, teaching or motivation simply takes the inventor’s disclosure for a blueprint for piecing together prior art to defeat patentability -- the essence of hindsight.” *In re Dembiczak*, 175 F.3d 999 (Fed. Cir. 1999) (citing *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138 (Fed. Cir. 1985)). Because the only teaching of the claimed combination appears in Applicants’ own disclosure, the Examiner has failed to produce a supportable reason for combining the references, and this rejection amounts to nothing more than impermissible hindsight. Applicants therefore respectfully request that the rejection be withdrawn.

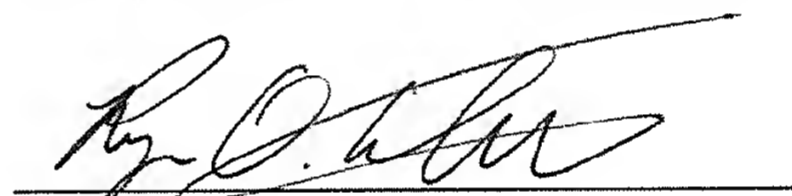
In view of the failure of Osborne and Bohrer, alone or in combination, to teach or suggest the patient supports as defined by the present claims, Osborne and Bohrer do not provide an enabling disclosure of the presently claimed invention nor place the presently claimed patient supports in the possession of the public. Thus, Osborne and Bohrer do not support a rejection under 35 U.S.C. § 103.

Finally, it is also noted that the Examiner did not address each of the claims individually in the Official Action, but instead rejected all of the claims together as a group. Claim construction is an essential part of the examination process that requires the Examiner to analyze each claim separately. See *In re Morris*, 127 F.3d 1048, 1053-54, 44 U.S.P.Q.2d 1023, 1027 (Fed. Cir. 1997). As the Examiner has not analyzed each claim separately, Applicants do not acquiesce in the Examiner's rejections as applied to all of the claims.

If necessary, Applicants request that this Amendment be considered a request for an extension of time for a time appropriate for the response to be timely filed. Applicants request that any required fees for filing this Amendment be charged to the account of Bose McKinney & Evans LLP, Deposit Account Number 02-3223.

Respectfully submitted,

BOSE McKINNEY & EVANS

A handwritten signature in black ink, appearing to read "Ryan O. White", is written over a horizontal line.

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